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Reply to Office Action of: 12/22/2008

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**FEB 24 2009**

has indicated. However, column 7, lines 6-9 notes that compressive force of the control wire 34D will tend to act along the entire formable length 30 (36A, 36B, 36C, 36D) of the catheter. Likewise, compressive force of the control wire 34c will tend to act along the entire lengths 36A, 36B and 36C. Likewise, compressive force of the control wire 34B will tend to act along the entire lengths 36A and 36B. Compressive force of the control wire 34A will tend to act along the length 36A only. Thus, pulling on control wire 34D will curve length 30 (36A, 36B, 36C, 36D). Pulling on control wire 34C will curve lengths 36A, 36B, 36C. Pulling on control wire 34B will curve length 36A, 36B. Pulling on control wire 34A will curve length 36A.

Claim 1, on the other hand, claims that the first active deflection section is limited to deflection in a first plane and the second active deflection section is limited to deflection in a second different plane. In view of the structure described in Boury, **this is not possible in Boury.**

The examiner is directed to MPEP 2141(II) (B) and 2141.02(VI).

As noted in MPEP 2141(II) (B):

"Ascertaining the differences between the claimed invention and the prior art requires interpreting the claim language, see MPEP §2111, and considering both the invention and the prior art as a whole. See MPEP §2141.02." (emphasis added).

As noted in MPEP 2141.02(VI):

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"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)." (emphasis added)

In the present case it appears that the examiner has been ignoring the portions of Boury which teach away from applicant's claimed invention. Column 8, lines 8-11 of Boury, referring to Fig. 2, states that "In reality, such a clear, precise demarcation is somewhat unlikely. In particular, the first curve 36A may curve upwardly somewhat along its length, deviating from the plane A, due to the tension on the control wire 34B." This is because, as noted above, compressive force of the control wire 34B will tend to act along the entire lengths 36A and 36B; thus pulling on control wire 34B will curve both lengths 36A and 36B (not 36B alone).

Thus, Boury explains that the first and second active deflection sections are not limited to first and second planes as claimed in claim 1. What is shown in Fig. 2 of Boury is inaccurate and, thus, fails to provide an "enabling disclosure" for a first active deflection section limited to deflection in a first plane and a second active deflection section limited to deflection in a second different plane. Therefore, Boury should not be used as a disclosure of a first active deflection section limited to deflection in a first plane and a second active deflection section limited to deflection in a second different plane.

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Claim 1 is not anticipated by Boury. Claim 1 is patentable and should be allowed.

Though the claims dependent upon claim 1 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 1. However, to expedite prosecution at this time, no further comment will be made.

Independent claim 11 claims that the first and second active deflection sections are adapted to deflect such that a distal end of the nephroscope can be placed in a calyx of a lower pole of a kidney without the need to passively deflecting the front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole. There is no disclosure or suggestion in Boury that the catheter is adapted to deflect such that a distal end of the nephroscope can be placed in a calyx of a lower pole of a kidney without the need to passively deflecting the front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole.

The examiner's discussion on page 8 of the office action relating to "intended use" is misplaced. The language of claim 11 is not merely "intended use". The language establishes structural limitations which are not disclosed or suggested in the cited art.

In this case, the claim language "first and second active deflection sections are adapted to deflect such that a distal end of the nephroscope can be placed in a calyx of a lower pole of a kidney without the need to passively deflecting the

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front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole" must be considered while evaluating patentability. There is no disclosure or suggestion of these structural and functional limitations in Boury. Thus, Boury does not "anticipate" claim 11.

In regard to Ex parte Masham cited by the examiner, as noted in that decision, the cited art needs to satisfy the structural limitations of that claimed. In Ex parte Masham the cited art was employed to mix developer material and the only question was whether or not the cited art was capable of being totally submerged in the developer material. In the present case, on the other hand, the questions is whether or not Boury is capable of having first and second active deflection sections deflect such that a distal end of the nephroscope can be placed in a calyx of a lower pole of a kidney without the need to passively deflecting the front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole. There is absolutely no disclosure in Boury that the structure in Boury is capable of this. The size and relative locations of a calyx of a lower pole of a kidney must be considered when evaluating whether or not Boury is capable of being placed in a calyx of a lower pole of a kidney without the need to passively deflecting the front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole. There is no disclosure of this in Boury. Clearly, since Boury teaches that compressive force of the control wire 34D will tend to act along the entire formable length 30 (36A, 36B, 36C, 36D)

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of the catheter and, thus, pulling on control wire 34D will curve the entire length 30 (36A, 36B, 36C, 36D), Boury clearly appears to be incapable of having first and second active deflection sections deflect such that a distal end of the catheter can be placed in a calyx of a lower pole of a kidney without the need to passively deflecting the front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole.

Claim 11 also claims that the first and second active deflection sections are each limited to deflection in a single common plane relative to each other. There is no disclosure or suggestion in Boury of first and second active deflection sections are each limited to deflection in a single common plane relative to each other.

The features of claim 11 are not disclosed or suggested in the cited art. Therefore, claim 11 is patentable and should be allowed.

Though the claims dependent upon claim 11 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 11. However, to expedite prosecution at this time, no further comment will be made.

Independent claim 19 claims that the first active deflection section is limited to deflection in a first plane and that the second active deflection section is limited to deflection in a second different plane. As noted above with respect to claim 1, column 7, lines 6-9 of Boury notes that compressive force of the control wire 34D will tend to act along the entire

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formable length 30 (36A, 36B, 36C, 36D) of the catheter. Likewise, compressive force of the control wire 34c will tend to act along the entire lengths 36A, 36B and 36C. Likewise, compressive force of the control wire 34B will tend to act along the entire lengths 36A and 36B. Compressive force of the control wire 34A will tend to act along the length 36A only. Thus, pulling on control wire 34D will curve length 30 (36A, 36B, 36C, 36D). Pulling on control wire 34C will curve lengths 36A, 36B, 36C. Pulling on control wire 34B will curve length 36A, 36B. Pulling on control wire 34A will curve length 36A.

Column 8, lines 8-11 of Boury, referring to Fig. 2, states that "In reality, such a clear, precise demarcation is somewhat unlikely. In particular, the first curve 36A may curve upwardly somewhat along its length, deviating from the plane A, due to the tension on the control wire 34B." Thus, Boury explains that the first and second active deflection sections are not limited to first and second planes as claimed in claim 1.

What is shown in Fig. 2 of Boury is inaccurate and, thus, fails to provide an "enabling disclosure" for a first active deflection section limited to deflection in a first plane and a second active deflection section limited to deflection in a second different plane. Therefore, Boury should not be used as a disclosure of a first active deflection section limited to deflection in a first plane and a second active deflection section limited to deflection in a second different plane. Boury does not describe the claimed invention (a first active deflection section limited to deflection in a first plane and


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a second active deflection section limited to deflection in a second different plane) in sufficient detail to enable a person of ordinary skill in the art to carry out the claimed invention. Thus, Boury does not provide an enabling disclosure and cannot be considered as anticipating claim 19. Boury clearly indicates that deflection of the first active deflection section is not "limited" to a first plane, but instead occurs in both a first plane and a second plane.

The features of claim 19 are not disclosed or suggested in the cited art. Therefore, claim 19 is patentable and should be allowed.

Though the claim dependent upon claim 19 contain its own allowable subject matter, this claim should at least be allowable due to its dependence from allowable claim 19. However, to expedite prosecution at this time, no further comment will be made.

Respectfully submitted,

  
Mark F. Harrington (Reg. No. 31,686)

2/24/09  
Date

Customer No.: 29683  
Harrington & Smith, PC  
4 Research Drive  
Shelton, CT 06484-6212  
203-925-9400

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Elaine F. Mian  
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